

### **REMARKS**

The Non-Final Office Action mailed June 25, 2008, has been received and reviewed. Prior to the present communication, claims 18-50 were pending in the subject application. All claims stand rejected under 35 U.S.C. § 103(a). Each of claims 18, 19, 33, and 41 has been amended herein, while no claims have been canceled or added. As such, claims 18-50 remain pending. It is submitted that no new matter has been added by way of the present amendments. Reconsideration of the subject application is respectfully requested in view of the above amendments and the following remarks.

#### **Support for Claim Amendments**

Independent claims 1 and 45 have been amended herein to recite a clarification of the processes of providing coaching to a learner and providing the learner with access to a response of an expert. Support for these claim amendments may be found in the Specification of the published application, for example, at pg. 3, ¶¶ [0035] and [0041], and at pg. 4, ¶¶ [0045] and [0050].

In general, amendments to the claimed subject matter is not "new matter" within meaning of 35 U.S.C. § 132 or Rule 118 of Patent Office Rules of Practice, unless it discloses an invention, process, or apparatus not theretofore described. Further, if later-submitted material simply clarifies or completes prior disclosure it cannot be treated as "new matter."<sup>1</sup> Accordingly, because these amendments are explicitly discussed, and inherent to, the procedure of developing critical thinking, as memorialized in the Detailed Description, the newly recited subject matter does not constitute new matter.

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<sup>1</sup> *Triax Co. v Hartman Metal Fabricators, Inc.*, 479 F2d 951 (1973, CA2 NY); cert. denied, 94 S. Ct. 843 (1973).

**Rejection under 35 U.S.C. § 103 based on U.S. Patent No. 6,736,642 to Bajer et al.**

Claims 18-50 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,736,642 to Bajer et al. (hereinafter the “Bajer reference”) in view of Official Notice. As the Bajer reference and the knowledge of one of ordinary skill in the art at time of the invention, whether taken alone or in combination, fail to teach or suggest all of the limitations of the rejected claims, Applicants respectfully traverse this rejection, as hereinafter set forth.

The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure.<sup>2</sup> To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art.<sup>3</sup> “All words in a claim must be considered in judging the patentability of that claim against the prior art.”<sup>4</sup> As such, it is contended that independent claims 18, 33, and 41, as amended herein, recite limitations that are not taught by the primary reference, Bajer, and are in condition for allowance.

Initially, claims 18, 33, and 41 are amended to recite a coaching function that *is invokable by a learner* to provide the learner with information before the learner submits answers and justifications. Further, the coaching function, when invoked, offers criteria that assists the learner in formulating his or her answers and justifications, where the *criteria provides details pertinent to the subject matter of each of the questions respectively*. The Bajer reference does not describe these features listed above. Instead, Bajer describes a feedback mechanism that is not able to be invoked prior to answering a question and provides information “dependent on the

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<sup>2</sup> See MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

<sup>3</sup> MPEP § 2143.03; *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

<sup>4</sup> MPEP § 2143.03; *In re Wilson*, 57 C.C.P.A. 1029, 1032 (1970)

progress and the decisions that they [the users] have made so far.”<sup>5</sup> This information provided by the feedback mechanism of Bajer is distinct from the information provided by the coaching function of the subject application (e.g., details pertinent to the subject matter of each of the questions).

Further, claims 18, 33, and 41 are amended to recite a expert functionality that receives and stores an expert’s answers and justifications and provides the expert answers and justifications to a learner, *where the expert comprises an expert in the field of the questions and is distinct from the learner*. The Bajer reference does not describe these features listed above. Instead, Bajer describes a physiologist that is not selected as an expert in the field of the inquiries and provides information based on the user’s answers.<sup>6</sup> This information is not an independent answer from an entity independent from the learner.

Moreover, independent claim 18 is amended to recite a learner interface module to facilitate the learner’s interaction with other learners that have provided other answers and justifications to the questions. The Bajer reference does not describe an operation that allows a user to interact with other users that have specifically (a) responded to the question that the user responded to, and that have (b) provided both answers and justifications to that question. As such, it is respectfully submitted that a *prima facie* case of obviousness of independent claims 18, 33, and 41, and accordingly of dependent claims 19–32, 34–40, and 42–50 cannot be established based upon the asserted combination of references. As such, it is respectfully requested that the 35 U.S.C. § 103(a) rejection of these claims be withdrawn. Each of claims 18–50 is believed to be in condition for allowance and such favorable action is respectfully requested.

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<sup>5</sup> See *Bajer reference* at col. 13, ll. 49–53.

A prior art rejection should be based on an actual prior art reference while relying on Official Notice only where the facts asserted are well-known or of common knowledge in the art.<sup>7</sup> “[Facts asserted by official notice unsupported by documentary evidence] should be of notorious character and serve only to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.”<sup>8</sup> “It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.”<sup>9</sup>

The present Office Action relies solely on Official Notice of alleged common knowledge in the art as the principal evidence that, when combined with the Bajer reference, forms the basis of the 35 U.S.C. § 103 rejections. This reliance is improper as it is used as a basis for the rejection and is not based on facts that are so well-known that they are “capable of instant and unquestionable demonstration as being well-known.”<sup>10</sup> *A fortiori*, assertions of technical facts in areas of esoteric technology (*e.g.*, receiving an answer simultaneously with a justification) must always be supported by citation to some reference work recognized as standard in the pertinent art.<sup>11</sup> Accordingly, Applicants expressly reserve the right to request that the Examiner produce a citation to a prior art reference to support each of the 35 U.S.C. § 103 rejections.<sup>12</sup>

In this instance, the Office has not set forth the proper foundation for an Official Notice, nor established that receiving the answer and justification simultaneously are well-known

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<sup>6</sup> *Id.*, at col. 12, ll. 60-65.

<sup>7</sup> MPEP § 2144.02(A); *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (finding that notice of facts beyond the record which may be taken by the Examiner must be “capable of such instant and unquestionable demonstration as to defy dispute”).

<sup>8</sup> MPEP § 2144.03(E).

<sup>9</sup> *Id.*

<sup>10</sup> MPEP 2144.03(A).

<sup>11</sup> *Id.*

to a person of ordinary skill in the art, or may be recognized as inherent to the system of Bajer. As such, the asserted general conclusion concerning what is common knowledge to one of ordinary skill in the art without some concrete evidence in the record to support this finding will not support an obviousness rejection.<sup>13</sup> Accordingly, the Office's assertion of Official Notice is considered traversed pursuant to MPEP § 2144.03(D).

Moreover, without demonstrating as obvious the features of (a)-(c) above, the proposed combination offered by the Office does not meet the limitations of the claimed subject matter, and as a matter of law the Office's rejection cannot stand.

Further, dependent claim 19 recites a reference module operable to receive and store reference material and to provide said reference material to said learner, where *the reference module is invokable prior to the learner providing the answer such that, when invoked, the reference module reveals the reference material that is pertinent to the question presently being offered*. The Bajer reference does not describe these features, but instead, describes references that may be accessed after answering the inquiry. Further, the references of Bajer are not necessarily pertinent to the question presently offered, but rather, provide general training information. As such, for at least this reason, it is respectfully submitted that a *prima facie* case of obviousness of claim cannot be established based upon the asserted combination of references. As such, it is respectfully requested that the 35 U.S.C. § 103(a) rejection of this claim be withdrawn.

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<sup>12</sup> 37 C.F.R. § 1.104(d)(2).

<sup>13</sup> MPEP § 2144.03(B); *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

### CONCLUSION

For at least the reasons stated above, each of claims 18-50 is believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned—by telephone at 816.559.2136 or via email at btabor@shb.com (such communication via email is herein expressly granted)—to resolve the same prior to issuing a subsequent action.

It is believed that no fee is due in conjunction with the present communication. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112, referencing attorney docket number UNVN.106165.

Respectfully submitted,

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